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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,606	10/19/2001	Kevin R. Keegan	89190.072901/DP-304631	8160

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EXAMINER

ALEJANDRO, RAYMOND

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/032,606

Applicant(s)

KEEGAN ET AL.

Examiner

Raymond Alejandro

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see next page.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 2.Claim(s) withdrawn from consideration: 3-15.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Response to Arguments

1. Applicant's arguments filed 07/19/04 have been fully considered but they are not persuasive.
2. The main contention of applicants' arguments is premised in the assertion that "*the Mieney reference discloses nothing more than a fuel cell having an anode, cathode, and electrolyte without non-uniform electrical resistance*" and/or "*the Mieney reference does not in any way teach or suggest that: the electrical resistance of any one of the cathode, the anode or the electrolyte is non-uniform*". In this regard, it is first noted that the examiner has provided a substantive sound basis (in fact) and a technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art, and therefore, to assert that the claimed non-uniform electrical resistance is inherent to the very same nature of the construction material of the anode, cathode or electrolyte (*i.e. the electrical resistance of any body is intrinsically related to the chemical nature of its construction material, see Final Rejection at page 11, 1st full paragraph*). Applicants' attention is particularly directed to the Examiner's Note and Response to Arguments at page 11, 1st full paragraph (refer to the Examiner's Note in body of the rejection above and Response to Arguments at page 11, 1st full paragraph). In consequence, the prior art's fuel cell components seem to be identical except that the prior art is silent as to an inherent function, property and/or characteristic. In that, it is noted that the extrinsic evidence makes clear that the missing descriptive matter is necessarily present in the specific method described in the reference, and that it would be so recognized by persons of ordinary skill. As a result, once a reference teaching method appearing to be substantially identical is made the basis of the rejection, and the

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examiner presents evidence or reasoning tending to show inherency, the burden shifts to the application to show an unobvious difference. Hence, applicants need to prove the prior art does not necessarily or inherently possess the non-uniform electrical resistance characteristics characteristics, and/or property of his/their anode, cathode or electrolyte. *In re Fitzgerald* 205 USPQ 594, 596 and *In re Best* 195 USPQ 430 (See **MPEP 2112. Requirements of Rejection Based on Inherency**).

3. While applicants' reliance on the argument that the Mieney reference does not teach or suggest providing one of the anode, cathode and electrolyte with non-uniform electrical resistance might be valid, the fact is that nothing in the Mieney reference teaches or suggest providing one of the anode, cathode and electrolyte with uniform electrical resistance, too. Thus, the examiner has a reasonable basis to suspect that Mieney's cathode, anode or electrolyte can exhibit either uniform electrical resistance or non-uniform electrical. Thus, in the absence of factual evidence demonstrating that Mieney's cathode, anode or electrolyte exhibit one characteristic or the other, the above-mentioned examiner's position with respect to the specific electrical resistance (i.e. uniform or non-uniform) still stands for the reasons of record. In view of that, the examiner also asserts that it is not enough that applicant's representative personally believe that the prior art does not exhibit non-uniform electrical resistance characteristic to teach such inherently identified characteristic and/or property. That is to say, the arguments of counsel cannot take the place of evidence in the record. An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of inherent anticipation/obviousness (See **MPEP 2145 Consideration of Applicant's Rebuttal Arguments**).

RAM
Patent Examiner
AU 1745